

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appln. No.: 09/649,215

Applicants Lamkin et al.

Filed: August 28, 2000

Title: SOFTWARE ENGINE FOR COMBINING
VIDEO OR AUDIO CONTENT WITH
PROGRAMMATIC CONTENT

Examiner: VU, Tuan A.

Art Unit: 2193

Customer No.: 22242

Confirm. No.: 7416

Certificate of Transmission/Mailing

I hereby certify that this correspondence is being facsimile transmitted to the USPTO, transmitted via the Office electronic filing system, or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below:

9/7/07

Date

Steven M. Freeland
Attorney for Applicants
Reg. No. 42,555**RESPONSE TO NOTICE OF NON-COMPLIANT APPEAL BRIEF**

Mail Stop: APPEAL BRIEF - PATENTS

Hon. Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Dear Sir:

In responsive to the Notice of Non-Compliant Appeal Brief mailed August 9, 2007, as entered in the above-captioned matter, the Applicants' Appeal Brief filed March 1, 2007 was identified as defective for failure to provide an appropriate summary of claimed subject matter.

No specific issues were identified by in the Notice of Non-Compliant Appeal Brief with respect to the observation that the submitted brief does not contain a concise explanation of the

subject matter defined in each of the independent claims other than the Examiner providing the following explanation:

Applicants fail to acknowledge the requirements set forth in the 37 CFR 41.37c, 1v; that is, according to which, for EACH independent claim, identification of the specific subject matter being submitted for the Board of Appeal to review should have reference to (in terms of its weight in accordance to §112, 6th paragraph) a structural or functional material described in the Specification that would CORRESPOND with that specific subject matter. As set forth above, in item 4) the absence of any independent claim number in the Summary (of the claimed subject matter) identified along with its pertinent/corresponding 112, 6th description in the Specs will be considered not fulfilling the 41.37c1v in regard to the very subject matter appealed that should be in accordance to requirements of 41.37c1vii. The defective Appeal Brief will not be given more time than that which is prescribed as grace period under 37 CFR 1.136.

The Applicants, however, have acknowledged the requirements under 37 C.F.R. §41.37 and have carefully reviewed the summary section of the Appeal Brief filed March 1, 2007 and, with all due respect, find the presented text of the submitted brief to be fully compliant with the requirements of 37 C.F.R. §41.37. The subject matter of the independent claims is presented, in prose format, including references to the Figures and specification by page and line number (via corresponding footnotes) as well as reference characters, and 37 C.F.R. §41.37(c)(1)(v) fails to specify that each independent claim must be individually identified. Particular reference was made in the Notice of Non-Compliance with respect to the requirements of 37 C.F.R. §41.37(c)(1)(v). That section first requires:

A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawings, if any, by reference characters.

As Applicants previously demonstrated, this is exactly what the summary section in the prior submitted Appeal Brief provides. Again, the subject matter of the independent claims is presented, in prose format, including references to the Figures and specification by page and line number (via corresponding footnotes) as well as reference characters, and nowhere does 37 C.F.R. §41.37(c)(1)(v) require each independent claim be identified. As to the latter requirement

of 37 C.F.R. §41.37(c)(1)(v), the summary section even includes presentations of the figures that are referred to in this way.

This portion of the Code of Federal Regulations then provides as follows:

For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. §112, 6th paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

Again, this is exactly what the summary section in the Appeal Brief submitted on March 1, 2007 provided with respect to at least Claim 8. The Applicants submit that Claim 8 recites “means plus function” language, and as such Applicants acknowledged the requirements under 37 C.F.R. §41.37 and set forth in the summary section of the submitted Appeal Brief for each “means plus function” of at least Claim 8 reference is made to the specification by page and line number and to the drawings when appropriate by reference character to the structure, material or acts described in the specification as corresponding to each claimed “means plus function.” Therefore, Applicants respectfully submit that the Appeal Brief filed March 1, 2007 is fully compliant with the requirements of 37 C.F.R. §41.37(c)(1)(v).

There are no other specific requirements set forth in the Code of Federal Regulations. There is, in particular, no requirement that each independent claim be specifically identified other than in accordance with those claims containing means-plus-function language, which the prior submitted Appeal Brief provided; and any demand for such a presentation is beyond the requirements of the rules and regulations. The Applicants therefore respectfully submit that the summary of claimed subject matter section of the Appeal Brief submitted on March 1, 2007 was fully compliant with the requirements of the Code of Federal Regulations and is in suitable condition to support consideration by the Board.

However, to advance this Appeal, Applicants have provided the accompanying Substitute Appeal Brief that identifies each independent claim and provides a mapping of the independent

claim elements. Still further, the accompanying Substitute Appeal Brief provides a mapping of the means plus function limitations of Claim 8 to the corresponding reference to supporting description within the specification in compliance with 37 C.F.R. §41.37(c)(1)(v).

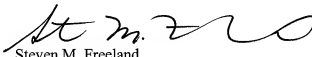
Applicants respectfully submit that the other pending claims do not include specific means plus function (or step plus function) recitations, and Applicants have provided in prose format summaries of at least the independent claims including representative references to the Figures and the Specification by page and line number (via corresponding footnotes) as well as reference characters. It will be understood that this summarization of the claimed subject matter is, in fact, a “summary” and that the Applicants do not represent or intend that this brief presentation, or the accompanying references to the drawings and the specification, comprises an exhaustive presentation in this regard. As always, the claims are to be viewed and interpreted in view of the context of the entire specification and the Abstract.

Therefore, Applicants respectfully request the Appeal Brief be entered and that the Appeal be advanced to the Board of Appeals.

Dated:

9/7/07

Respectfully submitted,



Steven M. Freeland
Reg. No. 42,555

Address all correspondence to:
FITCH, EVEN, TABIN & FLANNERY
Thomas F. Lebens
120 So. LaSalle Street, Ste. 1600
Chicago, IL 60603
(858) 552-1311